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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,399	07/25/2001	Chiaki Matano	211861US3	3527

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EXAMINER

CHOP, ANDREA MARIE

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/911,399

Applicant(s)

Matano

Examiner

Andrea Chop

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 18, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file.

### ***Drawings***

2. It should be noted that the drawings have not yet been reviewed by a PTO draftsman. The drawings will be reviewed upon allowance of the application and Applicant will be apprised of their status accordingly.

### ***Claim Rejections - 35 USC § 112***

3. Claims 2, 8 and 16-19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As concerns Claims 2 and 8, line 3, it appears that "and" should be changed to --an--.

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As concerns Claims 16 and 18, "a/said stone" is indefinite, since it is not clear whether this is the same stone as defined in Claim 1 (or 7) or is in addition to it; suggested claim language for correcting this issue is as follows: --... wherein only a single stone is fitted into said first ditch portion-- or similar.

As concerns Claim 17, "a stone" is indefinite, since it is not clear whether this is the same stone as defined in Claim 1 or is in addition to it; suggested claim language for correcting this issue is as follows: --... wherein only a single stone is fitted into said second ditch portion-- or similar.

As concerns Claim 19, "a stone" is indefinite, since plural stones have been defined and it is not clear which is being referred to; suggested claim language for correcting this issue is as follows: --... wherein only a single stone is fitted into said first ditch portion and only a single stone is fitted into said second ditch portion-- or similar.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-6 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tessler US 5,560,224 in view of the GPI Web Client Printout for JP 410075809A.

Tessler shows a band with a ditch portion and a stone, but lacks a stone fixed on opposite sides of the ring. JP '809 teaches that affixing stones to opposite sides of a ring is known. It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the ring to have a ditch portion and stone on opposite sides of the ring in view of JP '809 in order to provide a more interesting ring. In regards to the specific stones claimed, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to use any of the stones claimed, since the examiner takes Official Notice of the use of diamonds, sapphires, rubies, and emeralds in jewelry and the selection of any of these known stones to use would be within the level of ordinary skill in the art.

6. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tessler US 5,560,224 in view of the GPI Web Client Printout for JP 410075809A and Kirshbaum US 3,307,374.

Tessler and JP '809 teach the claimed invention, but lack initials. Kirshbaum teaches the use of indicia on rings. It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the ring to include indicia in view of Kirshbaum in order to provide a more personalized ring. In regards to the specific stones claimed, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to use any of the stones claimed, since the examiner takes Official Notice of the use of diamonds,

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sapphires, rubies, and emeralds in jewelry and the selection of any of these known stones to use would be within the level of ordinary skill in the art.

***Allowable Subject Matter***

7. Claims 16-19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Remarks***

8. In response to Applicant's arguments regarding the motivation of combining the Abstract of JP '809 and Tessler, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); and combining the teaching of the Abstract of JP '809 (which teaches having gem arrangements on opposite sides of a shank) with Tessler, would suggest taking Tessler's gem arrangement and including such structure on the opposite side of his shank also. In regards to Applicant's request showing

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different gemstones on opposite sides of a shank - the Abstract of JP '809 is pointed out, since this reference teaches incorporating two different gemstones in an arrangement with settings on opposite sides of the shank; the Examiner has taken Official Notice only of the fact that the use of diamonds, sapphires, rubies, and emeralds as gemstones is well known and substituting such stones for the stones of the Abstract of JP '809 would be within the skill of one of ordinary skill in the art. In response to Applicant's arguments regarding the nature of the Abstract of JP '809, the Examiner is relying on this reference only as a general teaching of placing gem settings on opposite sides of a shank; the ditch structure used in Tessler meets Applicant's claim limitations.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

***Patent Customers Advised to FAX Communications to the USPTO***

10. In view of delays in mail delivery in recent days, we at the USPTO would like to encourage you to communicate with the USPTO via facsimile. **Facsimile transmissions may be used for correspondence as set forth in 37 CFR 1.6 such as: amendments, petitions for**

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**extension of time, authorization to charge a deposit account, an IDS, terminal disclaimers, a notice of appeal, an appeal brief, CPAs under 37 CFR 1.53(d), and RCEs.**

PTO Form 2038 should be used when authorizing payment by credit card; this form is maintained separate from the file to ensure confidentiality.

The USPTO has recently installed server software that enables us to automatically receive facsimile transmissions and route them to the appropriate groups. No special equipment is needed by our customers to use this system other than a regular facsimile machine. Each Technology Center has its own facsimile numbers associated with our server for Official replies to non-final Office actions and for Official replies to final Office actions. In addition, each Technology Center has a Customer Service Center on our server system and can answer any general application status questions you might have, can provide Examiner information and answer paper queries. The following is a list of all Official Facsimile numbers for Technology Center 3600:

TC 3600:

Before Final 703-872-9326

After Final 703-872-9327

Customer Service 703-872-9325

By using the Official Before Final and After Final numbers, our server system will automatically generate a return receipt that will include the number of pages received as well as the date and time the facsimile was received. Additionally, the return receipt will include an image of the



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received cover page. Applicants are advised to use the certificate of facsimile transmission procedures when submitting a reply to a non-final or final Office action by facsimile (see 37 CFR 1.6 and 1.8). Applicants are also advised to retain the return receipt in the event that the Office has no record of the facsimile submission, whether the facsimile submission is a reply to an Office action (37 CFR 1.8(b)), or a continued prosecution application under 37 CFR 1.53(d) (37 CFR 1.6(f)).

**Note, however, the Office currently does not permit new application filings (other than a CPA under 37 CFR 1.53(d)), requests for reexamination, drawings, and certain correspondence set forth in 37 CFR 1.6(d) by facsimile.**

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*Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea Chop whose telephone number is (703) 305-6358.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.

AC  
AMC

February 3, 2003

  
WILLIAM MILLER  
PRIMARY EXAMINER  
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